

CS



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/916,214	07/25/2001	Theodore C. Johnson	37167-8040.US00	6833
22918	7590	11/16/2004	EXAMINER	
PERKINS COIE LLP P.O. BOX 2168 MENLO PARK, CA 94026			PEFFLEY, MICHAEL F	
			ART UNIT	PAPER NUMBER
			3739	

DATE MAILED: 11/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/916,214

Applicant(s)

JOHNSON ET AL.

Examiner

Michael Peffley

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 38-71 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 38-71 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 3739

Applicant's amendments and comments, received September 21, 2004, have been fully considered by the examiner. In particular, applicant's arguments with respect to the 35 USC 112, first and second paragraph, rejections are deemed persuasive. Applicant has sufficiently shown support in the originally filed specification for the claimed subject matter, and has persuasively argued that the claim language was clear. The following is a complete response to the September 21, 2004 communication.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 102

Claims 38-42 and 45-71 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Gough et al ('384).

Gough et al provide a device which comprises an elongate delivery device (18) maneuverable in tissue, and a plurality of resilient members (16) which are deployable into tissue with curvature. The resilient members are RF electrodes which may be used to treat tissue, and the electrodes include sensors (24) for measuring tissue impedance and using that measurement to monitor the ablation of tissue and control the delivery of RF energy. A multiplexer is used to control the delivery of data between the multiple resilient members (see col. 9, lines 37-40). Resources are provided for using the impedance data to control the procedure (Figures 9 and 10). A variety of energy sources may be used to provide energy to the electrodes, including RF, microwave and laser energy, or a combination of these (col. 6, lines 35-47). Also, Gough et al teach that the device may be operated in either a monopolar or a bipolar mode and may be

Art Unit: 3739

switched between the two modes (col. 7, lines 40-45). It is noted that many of the claims include recitation of the device "configured to" perform various functions. This language is not deemed to present any specific structure or means supportive of the recited functions, and the Gough et al system is deemed to be capable of performing these functions.

While Gough et al disclose the use of multiple energy sources connected to the plurality of electrode/sensor members, there is no explicit disclosure that each electrode/sensor member is connected to a separate energy source. First, the examiner maintains that the Gough et al disclosure is as explicit as applicant's specification with respect to this limitation (i.e. applicant's disclosure also does not explicitly disclose this feature). The examiner maintains that the Gough et al disclosure inherently suggests the use of different energy sources for each electrode/sensor member, or that the use of a separate source for each electrode/sensor member would be an obvious consideration in view of the Gough et al teaching of using a combination of sources for the electrode/sensor members.

Claims 38-42 and 45-71 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Gough et al ('484).

Gough et al provide a device substantially identical to the Gough et al ('384) device. It includes an elongate delivery device and a plurality of resilient members (16) which are deployable into tissue with curvature. The resilient members are RF electrodes which may be used to treat tissue, and the electrodes include sensors (24)

Art Unit: 3739

for measuring tissue impedance and using that measurement to monitor the ablation of tissue and control the delivery of RF energy. A multiplexer is used to control the delivery of data between the multiple resilient members (see col , lines 40-45).

Resources are provided for using the impedance data to control the procedure (Figures 9 and 10). A variety of energy sources may be used to provide energy to the electrodes, including RF, microwave and laser energy, or a combination of these (col. 5, lines 1-12). Also, Gough et al teach that the device may be operated in either a monopolar or a bipolar mode and may be switched between the two modes (col. 7, lines 40-45). It is noted that many of the claims include recitation of the device "configured to" perform various functions. This language is not deemed to present any specific structure or means supportive of the recited functions, and the Gough et al system is deemed to be capable of performing these functions.

While Gough et al disclose the use of multiple energy sources connected to the plurality of electrode/sensor members, there is no explicit disclosure that each electrode/sensor member is connected to a separate energy source. First, the examiner maintains that the Gough et al disclosure is as explicit as applicant's specification with respect to this limitation (i.e. applicant's disclosure also does not explicitly disclose this feature). The examiner maintains that the Gough et al disclosure inherently suggests the use of different energy sources for each electrode/sensor member, or that the use of a separate source for each electrode/sensor member would be an obvious consideration in view of the Gough et al teaching of using a combination of sources for the electrode/sensor members.

Response to Arguments

Applicant's arguments filed April 12, 2004 have been fully considered but they are not persuasive.

Applicant contends that neither the Gough et al ('384) nor the Gough et al ('484) references disclose the use of separate energy sources for each sensor member. The examiner disagrees.

Specifically, applicant argues that both of the Gough et al references include electrodes which "may be switched between energy sources" and that it does not necessarily follow that each electrode is connected to a separate energy source (page 12 of applicant's response). The examiner maintains that each of the Gough et al references teaches not only that the electrodes "may be switched" between energy sources, but also that a plurality of energy sources may be connected to individual electrodes/sensors. In particular, Gough et al ('384) specifically teach that the individual electrodes/sensors may be connected to a combination of energy sources (i.e. more than one energy source). See Column 6, lines 35-47. The use of a combination of energy sources (i.e. one RF source and one microwave source) inherently provides for a separate energy sourced coupled to each of the electrodes/sensors. As each electrode (i.e. antenna) includes an impedance sensor, each sensor is connected to a separate energy source, as well.

Similarly, Gough et al ('484) discloses the use of a combination of energy sources (col. 5, lines 1-12). Again, the use of a combination of energy sources

Art Unit: 3739

inherently provides a separate energy source for each antenna (or, for at least two of the antennae).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

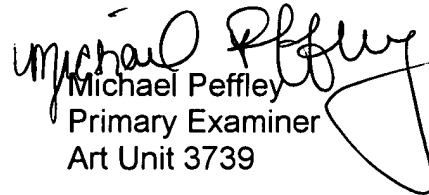
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Peffley whose telephone number is (571) 272-4770. The examiner can normally be reached on Mon-Fri from 6am-3pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3739

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Michael Peffley
Primary Examiner
Art Unit 3739

mp
November 12, 2004